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No. 455

IN THE

Supreme Court of the United States

OCTOBER TERM, 1943

LEROY J. LEISHMAN,

Petitioner,

v.

ASSOCIATED WHOLESALE ELECTRIC COMPANY, a corporation,

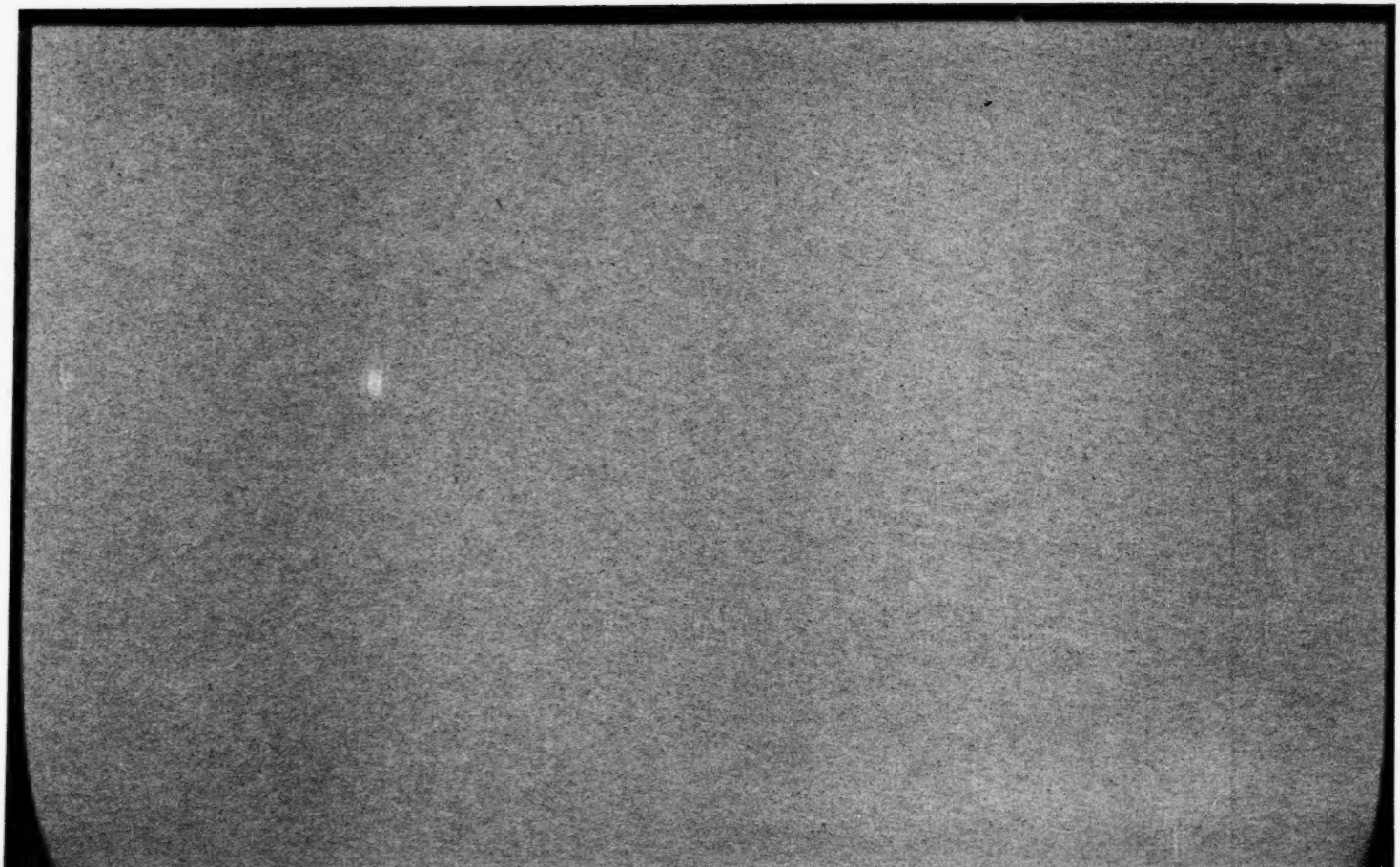
Respondent.

BRIEF OF RESPONDENT IN OPPOSITION TO PETITION FOR CERTIORARI

MARSTON ALLEN,
Counsel for Respondent.

ALDEN D. REDFIELD,
LEONARD S. LYON,
GIBSON YUNGBLUT,
Of Counsel.

THE JOHNSON & HARDIN CO., LAW PRINTERS
CINCINNATI, OHIO



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STATEMENT

On February 15, 1938 letters patent No. 2,108,538 were issued to LeRoy J. Leishman. The patent disclosed a device for simultaneously tuning two radio receivers, a receiver for television and a receiver for sound. It consisted of a pair of rocking members, one of which was to be attached to the tunable element of the sound receiver, and the other of which was to be attached to the tunable element of the television receiver. A lever was provided, carrying a pair of adjustable tappets or cams. When the

lever was swung down to an operating position (as in Figure 2 of the patent), each cam contacted its individual rocker and turned it to an angular position predetermined by the setting of the cam.

Prior to the issuance of this patent, The Crosley Radio Corporation (now by change of name, The Crosley Corporation), of Cincinnati, Ohio, had manufactured and placed on the market radio receiving sets having push button tuning devices. (Rec. Vol. II, p. 367.) In the Crosley structure there was a rocker and there was a cam or tappet to move the rocker. (Finding 10, Rec. Vol. I, p. 35.) The tappet, however, was mounted upon a plunger, not upon a lever (Finding 14, Rec. Vol. I, p. 36); and in other respects also the structure was physically different from that disclosed in the patent.

When the patent issued, Leishman notified Crosley of infringement, and a conference was arranged at Cincinnati, Ohio. At this conference Leishman was informed that Crosley did not believe it infringed any claims of his patent, among other reasons, because *every claim was limited in terms to a lever operated device.* (Rec. Vol. I, p. 125, Rec. Vol. II, p. 479.)

Thereafter, Leishman filed an application for reissue of his letters patent, and on August 16, 1938 obtained a reissue in which five additional claims were added to the original six claims of the patent. One of his purposes[1] was to secure claims not limited to a lever, but broad enough to embrace a plunger.[2]

Still later, namely on January 16, 1939, Leishman disclaimed his original claim 5. He did this because a patent No. 2,072,897 to Marschalk had been called to his atten-

[1] In the reissue claims he also introduced for the first time the idea of *coaxiality* between the tappet and the rocker when the tappet fully engages the rocker. This was also not the invention intended to be claimed in the original patent. (Finding 18, Rec. Vol. I, p. 36.)

[2] This was admitted by Leishman. (Rec. Vol. I, p. 126.)

tion (Rec. Vol. I, p. 132), disclosing as a radio tuner the combination of a rocker, a lever, and an adjustable cam or tappet, and meeting every element of original claim 5. (Finding 15, Rec. Vol. I, p. 36.)

In the meantime, Leishman brought this suit in Los Angeles, California, against Associated Wholesale Electric Company, a distributor handling the Crosley line. The Crosley Radio Corporation defended its customer.

The District Court in its decision held that the claims expressed no invention and dismissed the bill. (Rec. Vol. I, pp. 28-39, 36 Fed. Supp. 804.)

An appeal was taken and the case was argued on its merits before the Ninth Circuit Court of Appeals. That Court, sua sponte, raised the question of the timeliness of the appeal, and dismissed the appeal as untimely. [Rec. Vol. IV, pp. 688-9, 128 F. (2d) 204.]

This matter was considered by the Supreme Court on certiorari, and the Ninth Circuit Court of Appeals was reversed (318 U. S. 203, 63 S. Ct. 543); but the case has not previously been in this Court on any question going to the merits of the controversy.

Upon remand to the Ninth Circuit Court of Appeals for consideration of the merits, that Court handed down an opinion [Rec. Vol. V, pp. 700-716, 137 F. (2d) 722] holding the claims not infringed if valid, and saying:

> "If they (the reissue claims in suit) do not include levers, the claims are not for the same invention as the original patent and hence are invalid. If they do include levers the claims are not infringed, for the accused device contains no lever." (Rec. Vol. V, p. 715.)

Earlier in its opinion the Court, after pointing out that original claim 5 was disclaimed in its entirety, said:

> "Hence both the original patent and the reissue must be construed as if claim 5 had never been included in either; for the disclaimer 'speaks from the date of the original patent.'"

ARGUMENT

The treatment of original claim 5 by the Ninth Circuit Court of Appeals is the mainspring of Leishman's Petition for Certiorari. Petitioner, while maintaining that the claims of an original patent should not be taken as the measure of what the patentee *intended* to claim, objects nevertheless to a consideration of the original patent as though it had never contained the disclaimed claim 5. The inference is that this claim, had it been considered, would have evidenced an intention on Leishman's part not to limit himself to a lever.

The inference is wrong; but the employment of it is a confession that nothing else, at least, in the document evidences such an intention.[3]

Leishman disclosed a lever and nothing else. Nowhere in his specification is there mention of any other element to carry the tappet. Nowhere in his specification is there a hint or suggestion that anything else could be used. Nowhere in his specification is there any teaching of the necessary mechanical changes which must be made if some other element were employed. *Nor did he claim anything but a lever-operated mechanism in his original patent.*

Claim 5 Was Limited to a Lever Like All the Original Claims

The original patent contained six claims. Every one of these claims, except claim 5, not only was limited to a double tuner (a device with two rockers for simultaneously tuning a radio set and a television set), but also used the word "lever." Claim 5 was Leishman's only original claim

[3] Leishman himself can find nothing in the patent. The words "a simple manually operated control" are not a disclosure of anything. They are merely another name for the only thing Leishman disclosed—a lever. Nor does a statement that modifications may be made in the invention without departing from its spirit, amount to a *disclosure*.

which would read on a single tuner—a device with only one rocker. In that claim he did not use the word "lever"; but he expressed his combination of elements in such terms as could read only on a lever-operated tuner.

Petitioner on pages 3 and 4 of his petition, analyzes claim 5 (giving reference numerals to the patent drawing), and states that the "means movable about a pivot" is the tappet 61. But the claim calls for, "means movable about a pivot and acting upon operation in one direction" to position the rocker in the act of tuning. The element stated by the claim cannot be the tappet alone, for the tappet does not respond to the language of the claim. The tappet cannot and must not be movable about its pivot during the act of tuning, for if it is, it cannot move the rocker. The only means which is or can be movable about a pivot during tuning is the lever assembly comprising the lever F moving on the pivot Q. Further, the claim calls for "a spring for holding *said means* in a normally inoperative position." The spring 73 engages the lever F, not the tappet 61. Moreover, if the means movable about a pivot is restricted to the tappet, then the claim states no operative combination, for it contains nothing to move the tappet, and nothing to lock the tappet so that it can position the rocker.[3a]

Respondent uses a sliding plunger; and a plunger is not a pivoted means.

Original claim 5 was thus as much limited to a lever as any of the other claims. Indeed, Crosley's explanation of this to Leishman was what led him, he said in testimony, to seek a reissue (Rec. Vol. I, p. 126).

[3a] Recognizing these difficulties, Leishman in such reissue claims as claim 7, said: "means *adjustably* movable about a pivot" (thus recognizing that the tappet must be locked during tuning), "and acting upon *bodily* movement" (thus recognizing that there is some unspecified element to hold and move the tappet). In such claims as reissue claim 9, he calls for "a manually movable operating means comprising an adjustably mounted positioning element."

The Ninth Circuit Followed the Industrial Chemicals Case

The Ninth Circuit Court of Appeals said in its opinion:

> "Thus a reissue patent must be for the same invention as the original patent. Otherwise it is invalid. An original patent and a reissue patent are not for the same invention unless what is covered by the reissue was disclosed in the original and was intended to have been covered and secured by the original. And this intention 'must appear from the face of the instrument'."

This seems a literal, if abridged, rendition of the words of the Supreme Court in *U. S. Industrial Chemicals, Inc.* v. *Carbide and Carbon Chemicals Corp.*, 315 U. S. 668, where it was said:

> "The question is whether, in the light of the disclosures contained in the two patents they are for the same invention. This Court has said that they are the same if the reissue fully describes and claims the very invention intended to be secured by the original patent; if the reissue describes and claims only those things which were embraced in the invention intended to have been secured in the original patent; if the broader claims in the reissue are not merely suggested or indicated in the original specification but constitute parts or portions of the invention which were intended or sought to be covered or secured by the original patent. The required intention does not appear if the additional matter covered by the claims is not disclosed in the original patent. . . . It must appear from the face of the instrument that what is covered by the reissue was intended to be covered and secured by the original."

The Court of Appeals held, on the subject of disclosure:

> "Thus the specification of the original patent discloses a combination comprising rockers, tappets and levers constituting what the specification calls a lever

assembly; and the claims of the original patent are for combinations each of which includes a lever or levers. *No leverless combination is disclosed . . . in the original patent. . . .*" (Italics ours, Rec. Vol. V, pp. 711-2.)

This holding appears to have been overlooked by Petitioner. It is not set up as error. Yet the defect of lack of disclosure on which to found leverless claims is itself fatal to the reissue, as held by this Court in the *Industrial Chemicals* case.

Harmless Error Is Not Ground for Certiorari

Rather, Petitioner is complaining of the Court of Appeals' disregard of original claim 5, as a failure to consider something which might have indicated an intention to claim. But since claim 5 was itself limited to a lever device, a consideration of it could not have altered the other part of the Court of Appeals' holding:

> "No leverless combination is . . . claimed in the original patent, nor does it appear from the face thereof that any leverless combination was intended to have been covered or secured thereby." (Rec. Vol. V, pp. 711-2.)

Since the Court of Appeals held there was no disclosure of a leverless device in the original patent, and since claim 5 could read on no operative structure save one employing a lever, a consideration of claim 5 by the Court of Appeals could have made a difference only in the language of its opinion, not in the substance. Such a "difference, not affecting the essential rights of the parties, is no ground upon which this court should exercise its discretionary power of issuing a writ of certiorari." *Smith* v. *Vulcan Iron Works, Norton* v. *Wheaton,* 165 U. S. 518, 526.

Refusal of Certiorari Does Not Establish a Principle of Law

This Court has many times said, as in *Altoona Publix Theatres* v. *American Tri-Ergon Corp.,* 294 U. S. 477, that

a disclaimer speaks from the date of the original patent. Whether there is any exception to this rule is perhaps an interesting speculation. It is difficult for us to see how a claim which has been disclaimed because the combination it expresses is completely old can properly be taken, in any event, as indicative of the breadth with which a patentee intended to express an element *in some other and different combination.* In this case claim 5 was disclaimed because the Marschalk patent showed everything called for by the claim. When Leishman reissued his patent he not only broadened the expression of the moving element to escape the limitation to a lever, but he began to claim for the first time coaxiality of the axes of the tappet and rocker, thus shifting his ground completely and basing his claim to originality on *coaxiality* in a combination otherwise admittedly old. Had claim 5 not been limited to a lever, it still could not have been indicative of any alleged breadth of Leishman's concept in some other and different "invention."[4]

But should the Supreme Court feel that a disclaimed claim can nevertheless be considered in determining the intention of an original patentee, still the circumstances of this cause indicate that a consideration of claim 5 could have made no difference in the final result.

The question, therefore, has here no standing on the merits of the controversy. Denial of certiorari imports no opinion by the Supreme Court on the merits of the case, and does not affirm it as a precedent. *United States* v. *Carver,* 260 U. S. 482; *Hamilton Brown Shoe Co.* v. *Wolf,* 240 U. S. 251; *Atlantic Coastline Railway Company* v. *Powe,* 283 U. S. 401.

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[4] Leishman never taught how coaxiality could be obtained in any but a lever-operated device; and in a plunger device it cannot be obtained in the same way. (Rec. Vol. II, pp. 412-414.)

There Is No Conflict of Decisions on Any Point Here Involved

It has been urged that there is a conflict between the decision of the Ninth Circuit Court of Appeals here and the decision of the Second Circuit in *Monogram Mfg. Co.* v. *Glemby Co.*, 136 F. (2d) 961. In that case the claims of the original patent related to a hair curler which had been shown with a spring in the drawings, and had been described with a spring in the specification. By reissue some claims were secured which omitted the spring. The spring, of course, was not necessary to the operation of the device.

The stated objects of the invention concerned themselves with functions to which the spring was not vital. While a spring had been shown and described, the specification *stated* that the patentee had no intention of confining himself to the details of the exemplary embodiments shown. One of the *original* claims (claim 4) was not limited to a spring. Moreover, there was in that case a very real showing of inadvertence, accident and mistake.

That a patentee, who, through inadvertence, accident and mistake, has claimed a mechanical device with the inclusion of an obviously unnecessary element, should be permitted by reissue to eliminate that element from certain claims, seems not unfair and is not in contravention of any of the pronouncements of this Court in the *Industrial Chemicals* case, in view of the circumstances found as facts by the Second Circuit. Especially so, since the patentee there was a Filipino, unfamiliar with the English language, who had tried to instruct his attorney to claim the invention both with and without the spring at the time the original application was filed, and who had furnished his attorney with a model not having the spring as well as with models having springs.

The difference here is manifest. Leishman is not trying by reissue to eliminate an unnecessary element from his claims. The lever is not a surplus element. If the lever is taken out of his disclosed structure, no operative combination is left. But having disclosed only a lever as the means for moving the tappet, having claimed only a lever, having made no hint in his specifications that anything else could be used, and having made no teaching *how* anything else could be used, he then sought, by reissue, claims broad enough to read on other undisclosed elements *as well as* the lever. If Leishman has actually succeeded in eliminating from any reissue claim the means to carry the tappet, then such a claim is invalid as covering an incomplete and inoperative combination.

The Question of Equivalency Is Not Involved

The Court of Appeals here held that levers and plungers are not equivalents, and this is complained of by Petitioner. There are many reasons why plungers are not the equivalent of levers, but the fact that lever tuners, which are bulky "cash register" devices, have not met with commercial success, whereas plunger tuners, which, because of the plungers, can be made tiny enough to be used in the smallest table model radios, have been accepted by the public, should be indicative. (See Fact Findings 9, 11, 13, and 14, Rec. Vol. I, pp. 35-6.)

Petitioner himself was unwilling to rely on the doctrine of equivalency, for when he reissued his patent, he took care to broaden the expression of the member which bore the tappet.

But in any case, concurrent findings by the District Court and the Court of Appeals that plungers and levers are not equivalents, give no basis for review by certiorari.

CONCLUSION

Since certiorari is discretionary, we believe we should call the Court's attention to these facts:

1. The District Court considered the reissue claims of the patent and found them void for want of invention. He found it unnecessary to pass upon any other defense.

2. The Court of Appeals held the reissue invalid if the claims read on other than a lever device, and since the claims would not be infringed if still limited to levers, it felt there was no need to go further.

There were other defenses.

3. The reissue patent is not for the same invention as the original, because in the reissue claims Leishman for the first time introduced the aspect of coaxiality, and began to claim that his invention lay in that feature added to a combination otherwise admittedly old. The District Court held:

> "The coaxial relation between the tappet and the rocker was not the invention intended to be secured in the original patent No. 2,108,538. The coaxial relationship was not claimed in the original patent, and is an afterthought in the reissue patent in suit brought into being to save the patent from the defense of anticipation." (Finding 18, Rec. Vol. I, p. 36.)

But the District Court felt it more fundamental that the claims, expressing coaxiality, nevertheless expressed nothing patentably new. He held them invalid for want of invention,[5] and dismissed the complaint. The Court of Appeals felt the patent was bad at the outset if, as contended, its reissue claims now read on a leverless device. There it stopped.

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[5] See Findings 19-23, Rec. Vol. I, p. 37. The District Court said:

"Coaxiality, which simply means being on-centers, is a mechanical principle hundreds of years old and must be considered in all machine designing when parts are to rotate together. . . . Coaxiality is old in the art, and the coaxial feature of the patent sued upon is the result of the use of mechanical skill."

4. The patent is also invalid because qualifying disclaimers, contrary to this Court's rule in the *Altoona Publix Theatres* case, were filed as to reissue claims 8, 9, and 10. This is apparent on the face of the document. No court has as yet passed upon it.

5. The facts set forth in our Statement (above) establish a clear situation of intervening rights under *Sontag Chain Stores Co. Ltd.* v. *National Nut Company of California,* 310 U. S. 281. No court has as yet passed upon it, excepting that the District Court found the facts (see Findings 7 and 8).

6. There was also a defense of non-infringement.

Should this Court accept the case on certiorari, Respondents would expect to urge these defenses. But it is also clear that this case does not present a basis for certiorari in the light of this Court's holding in *Keller* v. *Adams-Campbell,* 264 U. S. 314, 319, 320.

We submit that here the Court of Appeals has held a reissue patent invalid because it is not for the same invention as the original if, as contended, the claims have been broadened, because

(a) there is no disclosure in the original which would support such broader claims, and

(b) there is nothing in the original specification to indicate any intention to make such broader claims, and

(c) no such broader claims had been made in the original patent, irrespective of disclosure.

Further, the Court of Appeals, in holding that plungers and levers are not equivalents, has clearly held that Respondent is not following the teachings of the patent in suit, though an effort has been made by a reissue to expand the claims of the patent to cover what the Respondent does.

> "These passages read in connection with the original and reissued patents and the alleged infringement show that what the Courts really held was that de-

fendants were manufacturing a different invention from that of the plaintiff's, and so could not and did not infringe. Such an ordinary patent case with the usual issues of invention, breadth of claims and non-infringement, this Court will not bring here by certiorari unless it be necessary to reconcile decisions of Circuit Courts of Appeal on the same patent." (*Keller* v. *Adams-Campbell,* supra.)

Thus, it seems a tenuous ground on which to base a request for certiorari, that the Court merely neglected to consider one of the claims under item (c) above, because that claim had been disclaimed, when an examination of it shows that this claim also was a similarly limited claim, and when the record shows that knowledge of this was one of the things motivating Petitioner's application for reissue.

Respectfully submitted,

MARSTON ALLEN,
Counsel for Respondent.

ALDEN D. REDFIELD,
LEONARD S. LYON,
GIBSON YUNGBLUT,
Of Counsel.